

Application No.: 10/695,669

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REMARKS

I. Introduction

For the reasons set forth below, Applicants respectfully submit that all pending claims are patentable over the cited prior art references.

II. The Rejection Of Claims 42-45, 48-50, 52-55 And 57 Under 35 U.S.C. § 103

Under 35 U.S.C. § 103(a), claims 42-45, 48-50, 52-55 and 57 were rejected as being unpatentable over Shigehiro et al. (USP No. 6,741,387) in view of Takehiro et al. (JP 10-154603). Applicants respectfully traverse the above cited rejection for at least the following reasons.

With regard to the present invention, claims 42, 44 and 57 each recite, in-part, a display device comprising a plurality of particles having an electrostatic property contained in a gaseous phase provided between the pair of substrates, wherein the particles each comprise a parent particle as a core, and plural child particles fixed to the parent particle or to a second layer surrounding the parent particle in a manner to cover a substantially entire surface of the parent particle.

In contrast to the present invention, the particles disclosed in Takehiro do not cover substantially the entire surface of the parent particle. As is disclosed in the Abstract, the child particles 4 are discontinuously dispersed and deposited on the surface of the parent particle 13. Furthermore, the grandchild particles 2 are also discontinuously dispersed and deposited onto the child particles 4. As such, Takehiro fails to disclose the limitations of claims 42, 44 and 57 wherein the plural child particles are fixed to the parent particle or to a second layer surrounding

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the parent particle in a manner to cover a substantially entire surface of the parent particle. Nor is Shigehiro relied upon to remedy this deficiency.

In order to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 180 USPQ 580 (CCPA1974). At a minimum, as Shigehiro and Takehiro fail to teach or suggest a display device comprising a plurality of particles having an electrostatic property contained in a gaseous phase provided between the pair of substrates, wherein the particles each comprise a parent particle as a core, and plural child particles fixed to the parent particle or to a second layer surrounding the parent particle in a manner to cover a substantially entire surface of the parent particle, it is submitted that Shigehiro and Takehiro, alone or in combination, do not render claim 42, 44 and 57 obvious. Accordingly, it is respectfully requested that the § 103 rejection of claims 42, 44 and 57 be withdrawn.

Furthermore, there is no teaching or suggestion to suggest the desirability to combine the two above cited references. Applicants refer the Examiner to § 2141 of the MPEP entitled, "*Basic Considerations Which Apply to Obviousness Rejections*", part (B) which states, "The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination." In addition, it is well known that a patent composed of several elements is not proved obvious without identifying a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements (*KSR International Co. v. Teleflex Inc.*, 550 U.S. 14-15 (2007)). As stated above, the particles of Takehiro are unusable with the device of Shigehiro. Thus, there is no reason to combine the two cited prior art references.

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In addition, the Takehiro reference relates to V-type electric resistance temperature characteristic material (see, Takehiro, Title), whereas Shigehiro is directed to a display element in which the charged particles are used to display an image on a screen (see, Abstract of Shigehiro). As the two references are in completely different technical fields, it would not be readily obvious to combine them. Nor is the invention in Takehiro reasonably pertinent to the particular problem with which Shigehiro is concerned. Furthermore, Takehiro is unrelated to the present application as well. Thus, without any suggestion to combine the above cited references, which are in non-analogous fields and concern unrelated problems, and in addition to the argument recited above against combining the references, Applicants submit that the requisite motivation to combine Shigehiro and Takehiro to substantiate a rejection under 35 U.S.C. § 103 has not been demonstrated. As such, Applicants submit that the proposed combination is improper.

Accordingly, it is respectfully requested that the § 103 rejection of claims 42, 44 and 57 be withdrawn.

III. All Dependent Claims Are Allowable Because The Independent Claim From Which They Depend Is Allowable

Under Federal Circuit guidelines, a dependent claim is nonobvious if the independent claim upon which it depends is allowable because all the limitations of the independent claim are contained in the dependent claims, *Hartness International Inc. v. Simplimatic Engineering Co.*, 819 F.2d at 1100, 1108 (Fed. Cir. 1987). Accordingly, as claims 42, 44 and 57 are patentable for the reasons set forth above, it is respectfully submitted that all pending dependent claims are also in condition for allowance.

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IV. Conclusion

Having fully responded to all matters raised in the Office Action, Applicant submits that all claims are in condition for allowance, an indication of which is respectfully solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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